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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,572	01/03/2002	Scott A. McKenney	2216 P 003	5850
25541 7590 07/24/2007 NEAL, GERBER, & EISENBERG SUITE 2200 2 NORTH LASALLE STREET CHICAGO, IL 60602			EXAMINER ARAQUE JR, GERARDO	
			ART UNIT 3629	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/038,572	<b>Applicant(s)</b> MCKENNEY ET AL.	
	<b>Examiner</b> Gerardo Araque Jr.	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 26-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "time-phased response", "time-phased casualty projection", and "time-phased human impact profile".

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 26 – 49** are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Many features, the details of which described below, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The enablement requirement refers to the requirement of 35 U.S.C. 112, first paragraph that the specification describe how to make and how to use the invention.

The invention that one skilled in the art must be enabled to make and use is that defined

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by the claim(s) of the particular application or patent (MPEP 2164 [R-2] The Enablement Requirement).

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? (2164.01 Test of Enablement)

In regards to **claims 26D, 38D, and 46D**, the Examiner asserts that the applicant does not disclose how to properly select the appropriate data in order to estimate/predict the quantity of people likely to be affected by the emergency situation to characterize the scope of the emergency situation, and, as a result, would burden one skilled in the art with undue experimentation in order to repeatedly arrive on a quantity for the same given emergency situation.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 26 – 49** are rejected under 35 U.S.C. 101 because the invention fails to produce a “concrete” result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). The opposite of “concrete” is unrepeatable or unpredictable. Resolving this question is

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dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, because the invention cannot operate as intended without undue experimentation. See *infra*.

In regards to **claims 26D, 38D, and 46D**, the action of selecting data is subjective and will vary depending on the person doing the actual selection. What one person may deem as crucial information to an emergency situation may necessarily not be the same in someone else's point of view. As a result, the action of selecting the data necessary to assess the given emergency situation is not repeatable and will produce different results.

7. **Claims 26, 38, 46, and 49** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner asserts that the applicant failed to properly disclose how to generate a time-phased response, time-phased casualty projection, and time-phased human impact profile. The Examiner asserts that the applicant has only provided how to generate a regular response and not a time-phased response. Furthermore, the Examiner finds no explanation of how to

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properly create a time-phased human impact profile or a time-phased casualty projection.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 26 – 31 and 34 – 49** are rejected under 35 U.S.C. 102(e) as being anticipated by **Quick (PG Pub 2001/0056435 A1)**.

10. In regards to **claims 26 and 46 – 49**, **Quick** discloses a method for collecting, organizing, presenting and utilizing data for use by an emergence response team to respond to an emergency situation involving a facility, comprising:

collecting a plurality of facility data to characterize the facility for later recall by the emergency response team, the plurality of facility data including at least one of a photograph, a spherical image, a site plan, a floor plan, hazardous material storage data, and a plurality of resource data to characterize existing resources that are available to respond to an emergency situation, the plurality of resource data including at least one of resource type, resource quantity, resource location and resource availability (**Page 1 ¶ 18**);

storing the plurality of facility data and the plurality of resource data in memory on a computer (**Page 6 ¶ 83**);

selecting one of a predetermined plurality of options to identify a type of the emergency situation (**Page 1 ¶ 24 – 26, 3 – 4 ¶ 65**);

estimating a quantity of people likely to be affected by the emergency situation to characterize the scope of the emergency situation (**Page 2 ¶ 30, 3 – 4 ¶ 65**);

generating a time-phased response to the emergency situation during increments of time over a predicted duration of the emergency situation, comprising a time phased list of actions to be taken by the emergency response team and a time-phased list of resources further including any shortfall of said personnel and said supplies, wherein the time-phased response is generated based on at least one of the selected one of the predetermined plurality of options, the estimated quantity of people likely to be affected by the emergency situation, and the plurality of resource data (**Pages 2 – 6 ¶ 18 – 25, 31, 53, 65, 68, 78 – 79, 84; Fig. 3, 7A, 7B**);

entering real-time situational awareness data of the emergency situation comprising annotations describing at least one of a damage to the facility and decisions made by the emergency response team regarding placement of resources (**Page 6 ¶ 83**);

storing said real-time situational data in memory on the computer (**Page 6 ¶ 83**);  
and

generating an updated response to the emergency situation (**Page 6 ¶ 83**).

11. In regards to **claims 27 and 39**, **Quick** discloses wherein a responder assets management system is resident within said memory (**Page 2 ¶ 32**).

12. In regards to **claims 28 and 40**, **Quick** discloses wherein said responder assets management system includes at least one of an information module, a logistics module, an operations module, and a planning module (**Page 2 ¶ 42 – 47**).

13. In regards to **claim 29**, **Quick** discloses wherein said module includes a link to at least one of a local weather information source, a national weather information source, standard operating procedures, maps, pictures, and information categorized and populated by a user (**Page 3 – 4 ¶ 65**).

14. In regards to **claim 30**, **Quick** discloses wherein said logistics module is adapted to manage resources used during an emergency response, said logistics module managing equipment data comprising at least one of equipment type, owner, location, data and time of use, and date and time of return to owner, wherein said step of generating a response includes the step of determining availability of equipment for use in responding to the emergency situation (**Page 1 ¶ 19 – 24**).

15. In regards to **claim 31**, **Quick** discloses wherein said operations module includes a plurality of interfaces including at least one of a situational awareness interface, an operations manager interface and a status board interface, said method further including the step of accessing at least one of said plurality of interfaces when responding to the emergency situation (**Page 1, 5 ¶ 18 – 25, 78; Fig. 7A – 7B**).

16. In regards to **claims 34 – 36**, **Quick** discloses wherein said operations manager interface is adapted to remotely monitor the status of the emergency situation, said



method further including the step of creating a record of the status of the emergency situation including at least the time the emergency situation occurred and the nature of the emergency situation (**Page 2 – 5 ¶ 31, 53, 68, 78 – 79; Fig. 7A – 7B**).

17. In regards to **claim 37**, **Quick** discloses wherein said situations awareness data are transmittable for review at a remote location (**Page 3 ¶ 49**).

18. In regards to **claim 38**, **Quick** discloses a method for providing an automated response to a significant unplanned emergency situation, comprising:

collecting a plurality of resource data comprising equipment that is available to respond to the emergency situation (**Page 1 ¶ 18; Fig. 5**);

storing the plurality of resource data in memory on a computer (**Page 6 ¶ 83**);

selecting one of a predetermined plurality of options to identify a type of the emergency situation based on the known characteristics of the emergency situation (**Page 1, 3 – 4 ¶ 24 – 26, 65**);

entering a predicted number of people that are likely to be affected by the emergency situation to characterized the scope of the emergency situation (**Page 2, 3 – 4 ¶ 30, 65**);

generating a time-phased response to the emergency situation during increments of time over a predicted duration of the emergency situation, including a time-phased list of actions needed to respond to the emergency situation and a time-phased list of resources needed to respond to the emergency situation (**Pages 2 – 6 ¶ 18 – 25, 31, 53, 65, 68, 78 – 79, 84; Fig. 3, 7A, 7B**);

providing the list of actions needed and the list of resources needed to respond to the emergency situation through an interface to emergency response personnel (**Page 4, 6 ¶ 65, 86, 88**); and

tracking progress of the emergency situation when responding to the emergency situation by the emergency response personnel (**Page 1 – 4 ¶ 2, 27, 49, 67; Fig. 5, 9**).

19. In regards to **claims 41**, **Quick** discloses wherein said operations module includes a response options generator interface adapted to automatically generate said list of actions and said list of resources needed to respond to the emergency situation (**Page 1, 3 ¶ 18 – 25, 52**).

20. In regards to **claim 42**, **Quick** discloses further including the step of responding to the emergency situation by the emergency response personnel, wherein said step includes following said list of actions needed and said list of resources needed throughout the duration of said response to the emergency situation (**Page 1, 3 ¶ 18 – 25, 52**).

21. In regards to **claim 43 – 45**, **Quick** discloses that the information can be distributed either before or after the incident and the additional information can be used to update any outdated information or write post-incident reports (**Page 2 Column 2 Paragraph 31, Page 3 Column 1 Paragraph 53**). This would inherently require necessary information, such as the date and time, to be included in the reports and as well as when the most recent information was last updated. Moreover, the information that is stored in the secure database will offer emergency response personnel to determine the safer and best course of action for the situation at hand and what

equipment is necessary in order to deal with the incident properly (**Page 1 Column 2 Paragraphs 18 – 25, Page 4 Column 1 Paragraph 65, Figure 3**). Furthermore, with the use of the wireless communication additional information can be relayed from the incident site to the user in front of the computer connected to the secure database and track the activities being inputted to the secure database (**Page 4 Column 1 Paragraph 68, Page 5 Column 2 Paragraph 78 & 79, Figures 7A – 7B**).

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. **Claim 32 and 33** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Quick (Patent Application Publication Number US 2001/0056435A)** in view of **Associated Realty Property Management** (<http://web.archive.org/web/20000817071152/http://www.arpm.com/>).

24. In regards to **claim 32**, as best understood by the examiner, **Quick** is discussed above, but fails to teach implementing a virtual walkthrough of the location. However, it is well known in the art to offer virtual walkthroughs in order to allow someone to fully understand the actual layout of a location. Moreover, realty offices, such as **Associated Realty Property Management (ARPM)**, offer virtual walkthroughs to allow a tenant to fully appreciate the layout of an apartment that they fail to see on simple floor plans (<http://web.archive.org/web/20001208075700/www.arpm.com/ipix.asp>).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **Quick** in view of the teachings of **ARPM** to include a virtual walkthrough of a building in order to allow an emergency response team to fully understand the current layout of a floor and better prepare for the situation.

25. In regards to **claim 33**, **Quick** discloses wherein said situational awareness data further includes at least one of a floor plan, a site plan and a map, wherein at least one icon representing localized information is indicated on at least one visual representation of said situational awareness data to indicate location of a particular item of said localized information, said step of reviewing said situational awareness data further including the step of selecting said at least one icon to reveal said localized information (Page 1 – 2 ¶ 18, 43 – 47).

### ***Response to Arguments***

26. Applicant's arguments filed 6/15/07 have been fully considered but they are not persuasive.

### **Response to Affidavit**

27. The affidavit under 37 CFR 1.132 filed 6/15/07 is insufficient to overcome the rejection of claims 26 – 49 based on insufficiency of disclosure under 35 USC 112, first paragraph; and lack of utility under 35 USC 101.

#### **MPEP 716.09 Sufficiency of Disclosure**

Once the examiner has established a *prima facie* case of lack of enablement, the burden falls on the applicant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would have been able to make and use the claimed invention using the disclosure as a guide. *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973). Evidence to supplement a specification which on its face appears deficient under 35 U.S.C. 112 must establish

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that the information which must be read into the specification to make it complete would have been known to those of ordinary skill in the art. *In re Howarth*, 654 F.2d 103, 210 USPQ 689 (CCPA 1981) (copies of patent specifications which had been opened for inspection in Rhodesia, Panama, and Luxembourg prior to the U.S. filing date of the applicant were not sufficient to overcome a rejection for lack of enablement under 35 U.S.C. 112, first paragraph).

**Affidavits or declarations presented to show that the disclosure of an application is sufficient to one skilled in the art are not acceptable to establish facts which the specification itself should recite.** *In re Buchner*, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991) (Expert described how he would construct elements necessary to the claimed invention whose construction was not described in the application or the prior art; this was not sufficient to demonstrate that such construction was well-known to those of ordinary skill in the art.); *In re Smyth*, 189 F.2d 982, 90 USPQ 106 (CCPA 1951).

Affidavits or declarations purporting to explain the disclosure or to interpret the disclosure of a pending application are usually not considered. *In re Oppenauer*, 143 F.2d 974, 62 USPQ 297 (CCPA 1944). But see *Glaser v. Strickland*, 220 USPQ 446 (Bd. Pat. Int. 1983) which reexamines the rationale on which *In re Oppenauer* was based in light of the Federal Rules of Evidence. **The Board stated as a general proposition "Opinion testimony which merely purports to state that a claim or count, is 'disclosed' in an application involved in an interference . . . should not be given any weight.** Opinion testimony which purports to state that a particular feature or limitation of a claim or count is disclosed in an application involved in an interference and which explains the underlying factual basis for the opinion may be helpful and can be admitted. The weight to which the latter testimony may be entitled must be evaluated strictly on a case-by-case basis."

An affidavit can be used to overcome utility, however, the current affidavit does not overcome concreteness in that it does not provide an explanation of how repeatable results can be carried out by one having ordinary skill in the art. The current affidavit only provides evidence that only one skilled in the art and not one of ordinary skill in the art can perform the invention. Furthermore, 37 CFR 1.132 affidavits are frequently

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submitted to rebut prima facie obvious rejections under 35 USC 103. However, the Examiner asserts that the affidavit has not properly discussed the supposed errors of the rejection made under 35 USC 103, but only to the step of "estimating a quantity of people likely to be affected by the emergency situation to characterize the scope of the emergency situation." Affidavits may not be used to present disclosure, which should have been in the specification as filed. Affidavits may only be employed to present facts and/or other evidence to assist the Examiner to decide the ultimate legal question of whether the disclosure satisfies the requirements of 35 USC 112, first paragraph.

**Remarks**

28. Rejections toward claims 1 – 25 are withdrawn due to applicant's cancellation of claims 1 – 25. Newly submitted claims 26 – 49 are discussed above.

***Conclusion***

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure can be found in PTO-892 Notice of References Cited.

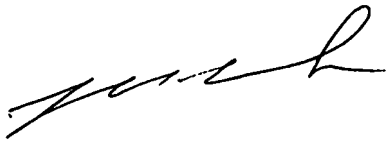
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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7/17/07



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